

U.S.S.N. 08/249,689
FILED: May 26, 1994
RESPONSE TO REQUEST FOR RECONSIDERATION OF
DECISION BY BOARD OF PATENT APPEALS AND INTERFERENCES

Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, P1 "Written Description" Requirement, 66 Fed. Reg. 1099, 1106)." (emphasis added).

In rebuttal to the statements in the Request for Reconsideration at page 3, the Federal Circuit also stated in *University of Rochester* at 926 "We of course do not mean to suggest that the written description requirement can be satisfied only by providing a description of an actual reduction to practice."

Also in contrast to *University of Rochester*, where the Court based part of its finding on the failure of Rochester to present evidence that the ordinary skilled artisan would be able to identify compounds based on a functional description, here the Appellant has provided objective evidence that even in the absence of the claimed limitations relating to complementarity to the minor groove of tRNA, one could identify compounds binding to the minor groove of RNA techniques and software available when this application was originally filed. No evidence was provided by the examiner to rebut this evidence, and there is no reference to it in the Request for Reconsideration.

VI. Conclusion

The Request for Reconsideration should be denied. The Request mischaracterizes the claims and the underlying facts that were taken into consideration by the Board of Patent Appeals in rendering its decision on October 30, 2003. The Request also implies that the Federal Circuit has somehow changed the written description requirement under 35 U.S.C. 112, in the

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decision rendered in *University of Rochester*. The claims now pending in this application comply with the written description requirement for the same reasons under *University of Rochester* as they did in the decision rendered October 30, 2003: the claims define compounds complementary (including appropriate hydrogen and other chemical bonds and structure) to the minor groove of the acceptor stem of a tRNA (a structural definition) which are effective to inhibit the function of the tRNA molecules (a functional definition). The application as originally filed provides an abundance of information on the structure of the minor groove of tRNA molecules, evidence that even minor changes to this structure inhibits the function of the tRNA molecules, and methods for making and testing the claimed compounds. The claims to the methods are allowable. Unrebutted expert evidence has been submitted stating that those skilled in the art would know the structure of the claimed compounds based on the complementarity of the compounds to the minor groove of the RNA. Finally, the Federal Circuit confirmed in *University of Rochester* that in genetic cases it can be sufficient to define the compounds in terms of complementarity to genetic material.

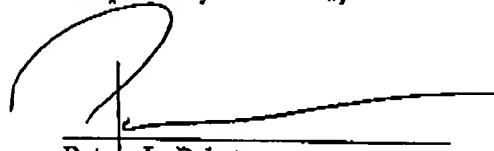
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Accordingly, the Board of Appeals should deny the Request for Reconsideration and
return the application to the examiner to be allowed.

Respectfully submitted,


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